

SUPPORT FOR THE AMENDMENTS

The present amendment cancels claims 8-10 and 15-17, and amends claims 2 and 14.

Support for the amendment to claims 2 and 14 is found at specification page 2, line 3, page 8, Table 1, Silica 1, page 9, Table 2, Silica 1, pages 22 and 23, Example 4, page 24, Table 6, Silica 1. It is believed that these amendments have not resulted in the introduction of new matter.

REMARKS

Claims 2, 6, 7, 11-14 and 18-22 are currently pending in the present application. Claims 8-10 and 15-17 have been cancelled, and claims 2 and 14 have been amended, by the present amendment. Claims 14-17 and 22 stand withdrawn from consideration by the Examiner as being directed to a non-elected invention.

Applicants wish to extend their appreciation to Examiner Nerangis for withdrawing the rejection of claims 2-13 and 18-20 under 35 U.S.C. § 102(b) as being anticipated over Bock (U.S. Patent 6,020,419).

The rejections of: (1) claims 2, 6, 9, 13 and 18-21 under 35 U.S.C. § 102(b) as being anticipated over Frahn (U.S. 2002/0077381); and (2) claims 2, 6-13 and 18-22 under 35 U.S.C. § 103(a) as being obvious over Bock (U.S. Patent 6,020,419) in view of Hartmann (U.S. Patent 5,959,005), are respectfully traversed in part, and obviated by amendment in part, with respect to claims 2, 6, 7, 11-14 and 18-22, which incorporates into claims 2 and 14 the limitation that the silanized, structurally modified pyrogenic silica have attached to the surface thereof *hexadecylsilyl* groups.

Amended claim 2 now recites a lacquer composition comprising: (1) from 20 to 80 wt. % of a polymer composition comprising polyesters, polyacrylates, polymethacrylates, mixtures or copolymers thereof; (2) from 0.5 to 25 wt. % of a silanized, structurally modified pyrogenic silica having attached to the surface thereof *hexadecylsilyl* groups, wherein said silanized, structurally modified pyrogenic silica has a tamped density of 123-322 g/L; (3) from 0 to 80 wt. % of one or more solvents; and (4) from 0 to 10 wt. % of an additive.

Frahn describes a coating composition comprising: an acrylate binder; and 1-20 %, preferably 2-10 %, of a silanized, structurally modified pyrogenic silica having a tamped density of 50-300 g/L and *hexamethyldisilazane* (HMDS) as a surface modifier (See e.g., [0006], [0008], [0012], [0017], [0021], [0024], [0027], claims 1, 2 and 4).

Bock describes a jet dispersion process for deagglomerating a coating composition by passing the coating composition through a nozzle, wherein the coating composition comprises: an acrylate binder; and 0.5-25 wt. %, preferably 2-20 wt. %, of a conventional (i.e., non-structurally modified) pyrogenic silica that has been surface modified with *hexamethyldisilazane* (HMDS) (See e.g., column 2, lines 50-67, column 3, lines 1-3, 28-33 and 52-67, column 4, lines 8-18, claims 1-6).

Hartmann describes producing structurally modified silica by a mechanical process using ball milling, and that the structurally modified silica may then be subjected to optional air jet milling (See e.g., column 1, lines 35-39, column 2, lines 18-20, claims 2 and 3).

Contrary to the Official Action, although the cited references describe pyrogenic silica that has been surface modified with *hexamethyldisilazane* (HMDS) groups (See e.g., Frahn at [0008]; Bock at column 3, lines 52-67), these references, when considered alone or in combination, fail to disclose or suggest modifying the surface of the pyrogenic silica described therein with *hexadecylsilyl* groups, as presently claimed. Therefore, the cited references fail to anticipate or render obvious to a skilled artisan the lacquer composition of the present invention.

Withdrawal of these grounds of rejection is respectfully requested.

The rejection of claims 2, 6-13 and 18-21 under 35 U.S.C. § 112, first paragraph (written description), is respectfully traversed with respect to claims 2, 6, 7, 11-14 and 18-22.

The originally filed specification is alleged as failing to provide adequate written description for recitations of the silanized, structurally modified pyrogenic silica having a tamped density of 123-322 g/L (claims 2 and 14), and 146-322 g/L (claims 21 and 22).

Pursuant to *In re Wertheim*, 541 F.2d 257, 265 (1976), the exact terms recited in the claimed invention need not be used *in ipsius verbis* or *in haec verba* in order to satisfy the written description requirement of 35 U.S.C. § 112, first paragraph. See also MPEP §§ 1302.01 and 2163.05(III). What is required is that the claimed invention must have been described with sufficient particularity such that a skilled artisan would recognize that the Applicants had possession of the claimed

invention when the application was filed. See 35 U.S.C. § 112, first paragraph, and MPEP § 706.03(c).

With respect to claims 2, 14, 21 and 22, the originally filed specification explicitly discloses and exemplifies silanized, structurally modified pyrogenic silica in accordance with present invention having a tamped density of 123 g/L, 146 g/L, 186 g/L, 204 g/L, 223 g/L, 236 g/L, 240 g/L and 322 g/L (See e.g., page 9, Table 2). Applicants respectfully submit that such a recitation and disclosure, intrinsically and inherently encompasses silanized, structurally modified pyrogenic silica having a tamped density of 123-322 g/L (claims 2 and 14), and 146-322 g/L (claims 21 and 22), as presently claimed. Applicants respectfully submit that a skilled artisan would immediately recognize that adequate support for the presently claimed invention has clearly been provided by the express, implicit and inherent disclosure set forth in the originally filed specification, as evidenced hereinabove. Since the specification describes the claimed invention in sufficient detail such that a skilled artisan would reasonably conclude that the inventors had possession of the claimed invention at the time of filing, recitations of silanized, structurally modified pyrogenic silica in accordance with the present invention having a tamped density of 123-322 g/L (claims 2 and 14), and 146-322 g/L (claims 21 and 22), as presently claimed, has not resulted in the introduction of new matter.

Withdrawal of this ground of rejection is respectfully requested.

In conclusion, Applicants submit that the present application is now in condition for allowance and notification to this effect is earnestly solicited.

Respectfully submitted,

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